

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KO-MIN CHANG,
BRUCE L. MORTON, CLINTON C. KUO,
KEITH E. WITEK
and
KENT J. COOPER

Appeal No. 95-3388
Application 08/242,993¹

ON BRIEF

¹ Application for patent filed May 16, 1994. According to appellants, the application is a continuation of Application 08/024,026, filed March 1, 1993, abandoned.

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Before KRASS, FLEMING and CARMICHAEL, *Administrative Patent Judges*.

FLEMING, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 42, all of the claims present in the application.

The invention relates to memory cell circuitry. In particular, a transmission gate is coupled to a storage device to function as a select gate for the storage device.

The independent claim 1 is reproduced as follows:

1. A memory cell comprising:

a voltage terminal;

means for storing a binary value coupled to the voltage terminal and formed as a single device selected from a group consisting of: a floating gate device, a ferroelectric storage device, and a ferromagnetic storage device;

a select gate having a first terminal coupled to only one of the means for storing and a second terminal, wherein the select gate is further characterized as being a transmission gate which comprises a plurality of transistors coupled in parallel; and

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a conductor coupled to the second terminal of the select gate for communicating with the memory cell.

The Examiner relies on the following references:

Dhong et al. (Dhong) 1990	4,910,709	Mar. 20,
Kawai et al. (Kawai) 1992	5,146,429	Sept. 8,

Claims 1 through 3, 5 through 13, 15 through 26, 28 through 30, 32 through 37, 40 through 42 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dhong and Appellants' prior art admission found on page 1, lines 11-21, of Appellants' specification. Claims 4, 14, 27, 31, 38 and 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dhong and Appellants' prior art admission found on page 1, lines 11-21, of Appellants' specification further in view of Kawai.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief and answer for the respective details thereof.

OPINION

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After a careful review of the evidence before us, we agree with the Examiner that claims 26 through 28, 30, 31 and 35 are properly rejected under 35 U.S.C. § 103. Thus, we will sustain the rejection of these claims but we will reverse the rejection of the remaining claims on appeal for the reasons set forth *infra*.

Turning to Appellants' claims 1 through 25, 29, 32 through 34 and 36 through 42, the Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), *cert. denied*, 117 S.Ct. 80 (1996) *citing W. L.*

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Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1548,
220 USPQ 303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851
(1984).

Appellants argue on pages 5 through 7 of the brief that neither Dhong nor the sentences found on page 1, lines 11-21, of the Appellants' specification teaches or suggests an EPROM, EEPROM, flash, non-volatile, or like device is interchangeable. Appellants argue that Dhong teaches a DRAM device and does not suggest using these other memory technologies. Appellants further argue that the sentences found on page 1, lines 11-21, are not an admission that one of ordinary skill in the art would have reason to modify the Dhong system by substituting the Dhong DRAM with these other memory technologies mentioned on page 1 of the Appellants' specification.

Upon our review of Appellants' specification, we find that Appellants' statements are only an admission that these other memory technologies are known, but does not suggest that these memories are interchangeable. We fail to find

that Dhong suggests any reason to substitute other memory technologies for the Dhong DRAM.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability. ***In re Denis Rouffet***, 1998 U.S. App. 16414 (Fed Cir. July 15, 1998).

Turning to Appellants' claims, we find that Appellants' claims 1 through 25, 33, 34, 36, 37, 40 through 42 recite memory

devices comprised of either a floating gate device, a ferroelectric storage device, a ferromagnetic storage device, an electrically erasable programmable read only memory (EEPROM), an electrically programmable read only memory (EPROM) or a flash floating gate memory. Upon a careful review of Appellants' specification, we find that Appellants' statements found on page 1 of the specification only admit that DRAM, SRAM, EEPROM, EPROM, flash EEPROM are known, but do not admit that one of ordinary skill in the art would have reason to substitute these memory technologies with dynamic random access memory technologies. Furthermore, we fail to find any suggestion by Dhong to substitute these memory technologies with the Dhong DRAM.

In addition, the Examiner has not shown that the prior art suggested the desirability of the Examiner's proposed modification. Furthermore, we fail to find that Kawai supplies this missing teaching or suggestion. Therefore, we find that the Examiner has failed to establish why one having ordinary skill in the art would have been led to the claimed invention by teachings or suggestions found in

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the prior art and we will not sustain the rejection of claims 1 through 25, 33, 34, 36, 37, 40 through 42 under 35 U.S.C. § 103.

Turning to the rejection of claims 29, 32, 38 and 39, Appellants argue that Dhong fails to teach or suggest a "decoding device having an N channel transistor connected in parallel with a P channel transistor." The Examiner does not address this issue. Upon a review of Dhong and Kawai, we fail to find such a teaching. Therefore, we will not sustain the rejection of claims 29, 32, 38 and 39 as well.

Turning to the rejection of claims 26 through 28, 30, 31 and 35 under 35 U.S.C. § 103, we note that Appellants have indicated on page 5 of the brief the groupings of the claims. However, Appellants have not argued claims 26 through 28, 30, 31 and 35 separately. 37 CFR § 1.192(c)(5) amended October 22, 1993 states:

For each ground of rejection which appellant contests and which applies to more than one claim, it will be presumed that the rejected claims stand or fall

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together unless a statement is included that the rejected claims do not stand or fall together, and in the appropriate part or parts of the argument under subparagraph (c)(6) of this section appellant presents reasons as to why appellant considers the rejected claims to be separately patentable.

As per 37 CFR § 1.192(c)(5), which was controlling at the time of Appellants' filing the brief, we will, thereby, consider

Appellants' claims 26 through 28, 30, 31 and 35 to stand or fall together.

We note that unlike the above claims, Appellants' claims 26 through 28, 30, 31 and 35 are not limited to a Markush group of memory technology that does not encompass the Dhong memory. Appellants' claims 26 through 28, 30, 31 and 35 are only limited to a Markush group that includes "a random access memory." We note that Dhong discloses a dynamic random access memory which is a random access memory. Therefore, we find that Dhong meets Appellants' Markush group limitation which is recited in these claims.

Furthermore, we note that Appellants have chosen not to argue any of the other specific limitations of claims 26

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through 28, 30, 31 and 35 as a basis for patentability. We are not required to raise and/or consider such issues. As stated by our reviewing court in ***In re Baxter Travenol Labs.***, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991), "[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." 37 CFR § 1.192(a) as amended at 58 Fed. Reg. 54510, Oct. 22, 1993, which was controlling at the time of Appellants' filing the brief, states as follows:

The brief . . . must set forth the authorities and arguments on which the appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief may be refused consideration by the Board of Patent Appeals and Interferences.

Also, 37 CFR § 1.192(c)(6)(iv) states:

For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If

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the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

Thus, 37 CFR § 1.192 provides that this board is not under any greater burden than the court which is not under any burden to raise and/or consider such issues. Therefore, we will sustain the Examiner's rejection of claims 26, 28, 30 and 35 under 35 U.S.C. § 103 as being unpatentable over Dhong and the Examiner's rejection of claims 27 and 31 under 35 U.S.C. § 103 as being unpatentable over Dhong and Kawai.

In view of the foregoing, the decision of the Examiner rejecting claims 26 through 28, 30, 31 and 35 under 35 U.S.C. § 103 is affirmed, but we reverse the rejection of claims 1 through 25, 29 and 32 through 34 and 36 through 42 under 35 U.S.C. § 103.

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No time period for taking any subsequent action in
con- nection with this appeal may be extended under 37 CFR
§ 1.136(a). ***AFFIRMED-IN-PART***

	ERROL A. KRASS)	
	Administrative Patent Judge)	
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)	BOARD OF
PATENT)	
	MICHAEL R. FLEMING)	APPEALS AND
	Administrative Patent Judge)	
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